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Paper 13
Date: January 16, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

TIKTOK, INC.,
Petitioner,

v.

SHOPSEE, INC.,
Patent Owner.

IPR2025-01485
Patent 11,134,316 B1

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

DECISION
Denying Institution of *Inter Partes* Review

Shopsee, Inc. ("Patent Owner") filed a request for discretionary denial (Paper 7, "DD Req.") in the above-captioned case, and TikTok, Inc. ("Petitioner") filed a corrected opposition (Paper 11, "DD Opp.").

After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution was appropriate in this proceeding. *See* Paper 12 ("Notice of Decisions on Institution" or "Notice"), 2. This determination was based on the totality of the evidence and arguments the parties presented, only a select portion of which is discussed in the following opinion identified as forthcoming in the Notice. *See id.*

In the Petition, Petitioner states that "[n]o express constructions are required to find the [challenged] claims invalid." Pet. 9. Patent Owner, however, argues that Petitioner asserted certain claim terms are indefinite in district court and does not explain why different claim construction positions between district court and the Board are warranted, which weighs in favor of discretionary denial. DD Req. 6–8. Petitioner responds that it "has now stipulated that it will not pursue the aforesaid indefiniteness arguments if this proceeding is instituted." DD Opp. 1–2.

"[W]hen a petitioner advances different positions before the Board and a district court, that petitioner is required to explain why those different positions are warranted." *Tesla Inc., v. Intellectual Ventures II, LLC,* IPR2025-00340, Paper 18 at 3 (Director Nov. 5, 2025) (informative) (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Director Nov. 3, 2025) (precedential)). Petitioner has not done so. Rather, Petitioner has stipulated that it will continue to pursue different constructions and abandon the inconsistent construction in district court if

the IPR is instituted. This is not in keeping with our precedent, and I decline to modify it to permit this approach.

Additionally, Petitioner's claim construction stipulation is distinguishable from its stipulation that "it will not pursue in the parallel litigation the grounds it raised or could have reasonably raised in the petition, and that it will not pursue any ground that relies on Ohliger or the Veepio system." DD Opp. 1–2. The latter stipulation increases efficiency by reducing duplication between the district court and the Board. It also minimizes the potential for inconsistent outcomes in the two proceedings. Petitioner's stipulation not to continue to advance *different* claim construction positions lacks similar benefits. At best, it replaces one argument in district court for another argument at the Board. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*, and no trial is instituted.

FOR PETITIONER:

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